

REMARKS/ARGUMENTS

Reconsideration of this Application is respectfully requested. Claims 1, 3-6, and 8-25 are pending in the present application. Claims 2 and 7 were previously cancelled. In the Office Action mailed December 18, 2006, the Examiner rejected pending claims 1, 3-6, and 8-25 on various grounds. In view of the following remarks, favorable consideration and allowance of the application is respectfully requested.

35 U.S.C. §102 Rejections

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Thus, to warrant the §102 rejection, the references cited by the Examiner must show each and every limitation of the claims in complete detail. The Applicant respectfully asserts that the cited references fail to do so.

- A. Claims 1, 3-6, 8-11, 13, 14, 17, 18, and 20-22 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Publication No. 2003/0204238 to Tedeschi (the *Tedeschi* publication).

The Applicant respectfully asserts that the *Tedeschi* publication fails to teach or suggest all the claim limitations.

Claims 1, 3-5, 8-10, and 22

The *Tedeschi* publication fails to disclose, teach, or suggest:

a stent delivery system including a stent having a first region and a second region, a first coating section disposed on the first region, and a second coating section disposed on the second region, wherein the first region and the second region are discrete, as recited in independent claim 1;

a coated stent including a stent having a first region and a second region, a first coating section disposed on the first region, and a second coating section disposed on the second region, wherein the first region and the second region are discrete, as recited in independent claim 6; or

a coated stent including a stent having a discrete first region and a discrete second region, a first polymer disposed on the discrete first region, and a second polymer disposed on the discrete second region, as recited in independent claim 22.

The *Tedeschi* publication discloses a uniform base coating layer with a second coating layer in the crimpable zones. The second coating layer adheres to the base coating layer. *See* paragraph [0034]. The coating 212 overlies the stent frame 214. *See* Figure 3; paragraph [0027].

The *Tedeschi* publication fails to disclose discrete first and second regions as claimed. The *Tedeschi* publication discloses a uniform base coating layer disposed over the whole stent frame. The second coating layer is disposed on the region occupied by the uniform base coating layer, not in a different, discrete region.

In addition, the uniform base coating layer of the *Tedeschi* publication would be part of the stent as claimed. The present invention defines the stent as being bare or having one or more uniform coatings over the stent to provide specific therapies, protect underlying layers, or promote coating adherence. *See* paragraph [0027]. The stent 120 may be any variety of implantable prosthetic devices capable of carrying a coating known in the art. *See* paragraph [0022]. While the specification is not to be read into the claims, the verbiage of the claims must be considered to possess their ordinary usage as would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in applicant's specification. *See* MPEP 2111.

The *Tedeschi* publication also fails to disclose first and second coating sections disposed on regions of a stent. The *Tedeschi* publication discloses a uniform base coating

layer disposed over the whole stent frame. The second coating layer is disposed on the uniform base coating layer, not on the stent.

Claims 3-5 and claims 8-10 depend directly or indirectly from independent claims 1 and 6, respectively, and so include all the elements and limitations of their respective independent claims. The Applicant therefore respectfully submits that the dependent claims are allowable over the *Tedeschi* publication for at least the same reasons as set forth above with respect to their independent claims.

Withdrawal of the rejection of claims 1, 3-5, 8-10, and 22 under 35 U.S.C. §102(e) as being anticipated by the *Tedeschi* publication is respectfully requested.

Claims 11, 13, 14, 17, 18, 20, and 21

The *Tedeschi* publication fails to disclose, teach, or suggest:

a method for producing a coated stent including providing a stent having a first region and a second region, applying a first polymer solution to the first region to form a first coating section, and applying a second polymer solution to the second region to form a second coating section, as recited in independent claim 11; or

a system for producing a coated stent including a stent having a first region and a second region, means for applying a first polymer solution to the first region to form a first coating section, and means for applying a second polymer solution to the second region to form a second coating section, as recited in independent claim 18.

As discussed above, the *Tedeschi* publication discloses a uniform base coating layer with a second coating layer in the crimpable zones. The second coating layer adheres to the base coating layer. *See* paragraph [0034]. The coating 212 overlies the stent frame 214. *See* Figure 3; paragraph [0027]. The *Tedeschi* publication fails to disclose discrete first and second regions, or first and second coating sections disposed on regions of a stent. The *Tedeschi* publication discloses applying a uniform base coating

layer over a whole stent frame, then applying a second coating layer to the uniform base coating layer.

Claims 13 and 14, and claims 18, 20, and 21 depend directly or indirectly from independent claims 11 and 17, respectively, and so include all the elements and limitations of their respective independent claims. The Applicant therefore respectfully submits that the dependent claims are allowable over the *Tedeschi* publication for at least the same reasons as set forth above with respect to their independent claims.

Withdrawal of the rejection of claims 11, 13, 14, 17, 18, 20, and 21 under 35 U.S.C. §102(e) as being anticipated by the *Tedeschi* publication is respectfully requested.

35 U.S.C. §103 Rejections

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references when combined must teach or suggest all the claim limitations. See MPEP 2143. To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). See MPEP 2143.03.

- B. Claims 12, 19, and 23-25 were rejected under 35 U.S.C. §103(a) as being unpatentable over the *Tedeschi* publication in view of U.S. Patent Publication No. 20020010505 to Richter (the *Richter* application).

The present application (Application No. 10/531,822) and the *Tedeschi* publication (U.S. Patent Publication No. 2003/0204238) were, at the time the invention of the present application was made, owned by Medtronic Vascular, Inc. The Applicant respectfully submits that this disqualifies the *Tedeschi* publication from being used in a rejection under 35 U.S.C. 103(a) against the claims of the present application. See MPEP 706.02(1)(2).

Withdrawal of the rejection of claims 12, 19, and 23-25 under 35 U.S.C. §103(a) as being unpatentable over the *Tedeschi* publication in view of the *Richter* application is respectfully requested.

- C. Claims 15 and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over the *Tedeschi* publication in view of U.S. Pat. No. 6,616,765 to Castro, *et al.* (the *Castro* patent).

The present application (Application No. 10/531,822) and the *Tedeschi* publication (U.S. Patent Publication No. 2003/0204238) were, at the time the invention of the present application was made, owned by Medtronic Vascular, Inc. The Applicant respectfully submits that this disqualifies the *Tedeschi* publication from being used in a rejection under 35 U.S.C. 103(a) against the claims of the present application. See MPEP 706.02(l)(2).

Withdrawal of the rejection of claims 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over the *Tedeschi* publication in view of the *Castro* patent is respectfully requested.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. 1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-5021.

Respectfully submitted,

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